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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,236	07/31/2001	Norman Yamamoto	2983-US	5853
63543 7590 05/14/2009 AVERY DENNISON CORPORATION Patent Group Law Department - 3 South P.O. BOX 7090 PASADENA, CA 91109-7090				
EXAMINER				
NORDMEYER, PATRICIA L				
ART UNIT		PAPER NUMBER		
1794				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/920,236

**Applicant(s)**

YAMAMOTO, NORMAN

**Examiner**

Patricia L. Nordmeyer

**Art Unit**

1794

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2, 4, 14, 20, 23, 24, 29-34 and 37-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 4, 14, 20, 23, 24, 29-34 and 37-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Repeated Rejections***

1. The 35 U.S.C. 103(a) rejection of claims 2, 4, 14, 20, 23, 24, 29 – 34, 39 and 40 over Haugwitz (USPN 4,961,811) in view of Vargas (USPN 4,889,754) in the office action dated November 25, 2008 is repeated as Applicant's arguments in the response dated March 25, 2009 are found to be unpersuasive. The rejection is repeated below for Applicant's convenience.

Haugwitz discloses a printable media (Column 2, lines 10 – 14), comprising: a sheet defining a front side (Figure 2), a rear side (Column 2, lines 51 – 53) and at least first and second intersecting side edges (Figure 2), each of the first and second side edges defining opposing longitudinal ends (Figure 2), one of the longitudinal ends of each of the first and second side edges defining a common longitudinal end (Figure 2); a plurality of first strips of adhesive material on one of the front and rear sides of the sheet adjacent to the first side edge (Figure 1; Column 2, lines 51 – 53) and extending substantially from one longitudinal end of the first side edge to the other longitudinal end of the first side edge (Figure 1; Column 2, lines 51 – 53) with a release liner covering the adhesive strips (Column 3, lines 12 – 17) as in claim 14. Haugwitz also discloses a printable media (Column 2, lines 10 – 14), comprising: an at least substantially opaque sheet (Column 2, lines 10 – 11) defining a front side (Figure 2), a rear side (Column 2, lines 51 – 53), first and second horizontally extending side edges (Figure 2), and first and second vertically extending side edges (Figure 2), each of the side edges defining opposing longitudinal ends (Figure 2); a plurality of horizontally extending strips of adhesive (Figure 2) on the rear side (Column 2, lines 51 – 53) of the at least substantially opaque sheet (Column 2, lines 10 – 11)

adjacent to the first horizontally extending side edge (Figure 2) and extending substantially from one longitudinal end of the first horizontally extending side edge to the other longitudinal end of the first horizontally extending side edge (Figure 2); wherein a release liner covers the adhesive material (Column 3, lines 13 – 17) as in claims 20 and 2. With regard to claim 23, the sheet comprises a paper sheet (Column 2, line 10). Regarding claims 24 and 29, the sheet is selected from the group consisting of an 8 ½ inch x 11 inch sheet, an 8 ½ inch x 14 inch sheet, and a 210 mm x 297 mm sheet (Column 2, lines 10 – 14). As in claim 34, the strips of adhesive material are on the rear side of the at least substantially opaque sheet (Column 2, lines 51 – 53); and the front side of the at least substantially opaque sheet includes indicia applied to the at least substantially opaque sheet (Column 2, lines 10 – 14). However, Haugwitz fails to disclose a plurality of second strips of adhesive material on the one of the front and rear sides of the sheet adjacent to the second side edge and extending substantially from one longitudinal end of the second side edge to the other longitudinal end of the second side edge, a plurality of first liners respectively positioned over the plurality of first strips of adhesive material; and a plurality of second liners respectively positioned over the plurality of second strips of adhesive material, the pluralities of first and second strips of adhesive material comprise a pressure sensitive adhesive, the pluralities of first and second strips of adhesive material comprise a permanent adhesive, each of the plurality of closely spaced horizontally or vertically extending release liners is spaced from another of the plurality of closely spaced horizontally extending release liners on the rear side of the opaque sheet, each of the plurality of closely spaced horizontally or vertically extending release liners is substantially parallel to another of the plurality of closely spaced horizontally extending release liners on the rear side of the opaque sheet, the plurality of first

strips of adhesive material includes at least one strip of permanent adhesive material; and the plurality of second strips of adhesive material includes at least one strip of permanent adhesive material, the plurality of horizontally extending strips of pressure sensitive adhesive is horizontally extending strips of permanent pressure sensitive adhesive; and the plurality of vertically extending strips of pressure sensitive adhesive is vertically extending strips of permanent pressure sensitive adhesive, the plurality of first liners includes mitered ends adjacent to the common longitudinal end of the first and second side edges and a liner corner member adjacent to the common longitudinal end of the first and second side edges.

Vargas teaches plurality of second strips of adhesive material on rear sides of the sheet adjacent to the second side edge and extending substantially from one longitudinal end of the second side edge to the other longitudinal end of the second side edge (Column 3, lines 1 – 15), a plurality of first liners respectively positioned over the plurality of first strips of adhesive material (Column 3, lines 1 – 15); and a plurality of second liners respectively positioned over the plurality of second strips of adhesive material (Column 3, lines 1 – 15), the pluralities of first and second strips of adhesive material comprise a pressure sensitive adhesive (Column 4, lines 59 – 61), each of the plurality of closely spaced horizontally or vertically extending release liners is spaced from another of the plurality of closely spaced horizontally extending release liners on the rear side of the sheet (Column 3, lines 1 – 15), each of the plurality of closely spaced horizontally or vertically extending release liners is substantially parallel to another of the plurality of closely spaced horizontally extending release liners on the rear side of the sheet

(Column 3, lines 1 – 15) for the purpose of selectively exposing the adhesive area (Column 3, lines 10 and 11).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the adhesive strips along both the horizontal and vertical edges and covered with release liners in Haugwitz since Haugwitz discloses that the size and numbers of lines of adhesive control the affixation of the adhesive (Column 2, lines 66 – 68) while Vargas teaches selectively exposing the adhesive area.

With regard to the limitations of "the plurality of first liners includes mitered ends adjacent to the common longitudinal end of the first and second side edges and a liner corner member adjacent to the common longitudinal end of the first and second side edges", it is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. In the instant case, the application does not indicate any new, significant attributes of the invention due to the shape of the release liner which would have been unforeseen to one of ordinary skill in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the release liner. One skilled in the art would have been motivated to do so in order to change the appearance of the overall product.

With regard to the limitation of "by a laser printer or an ink jet printer" in claim 34, a recitation of the intended use of the claimed invention must result in a structural difference

between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

2. The 35 U.S.C. 103(a) rejection of claims 35, 37 and 38 over Haugwitz (USPN 4,961,811) in view of Vargas (USPN 4,889,754) and Chen et al. (USPN 4,898,323) in the office action dated November 25, 2008 is repeated as Applicant's arguments in the response dated March 25, 2009 are found to be unpersuasive. The rejection is repeated below for Applicant's convenience.

Haugwitz, as modified with Vargas, discloses the claimed printable media except for the pluralities of first and second strips of adhesive material comprise a permanent adhesive, the plurality of first strips of adhesive material includes at least one strip of permanent adhesive material; and the plurality of second strips of adhesive material includes at least one strip of permanent adhesive material, the plurality of horizontally extending strips of pressure sensitive adhesive is horizontally extending strips of permanent pressure sensitive adhesive; and the plurality of vertically extending strips of pressure sensitive adhesive is vertically extending strips of permanent pressure sensitive adhesive.

Chen et al. teach that the adhesive is a permanent adhesive (Column 5, lines 25 – 26) that is covered by a release liner (Column 5, lines 26 – 29) as part of a printable media (Column 2, lines 9 – 10) of a standard or larger size paper (Column 1, lines 35 – 38) for the purpose of changing the formation of the printed media (Column 1, lines 50 – 52).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the permanent adhesive in the modified Haugwitz in order to change the formation of the printed media as taught by Chen et al.

***Response to Arguments***

3. Applicant's arguments filed March 25, 2009 have been fully considered but they are not persuasive.

In response to Applicant's argument that Applicant presumes that dependent claim 38 is allowable since the Office Action does include a specific rejection of dependent claim 38, there is a typo in the heading of the second rejection that says claim 39 instead of claim 38. If the body of the rejection is reviewed, the claim language of claim 38 is in the body of the rejection.

In response to Applicant's argument that Haugwitz patent fails to teach or suggest "a plurality of vertically extending strips of pressure sensitive adhesive...adjacent to the first vertically extending side edge..." as required by claim 20, Haugwitz clearly teaches "a plurality of vertically extending strips of pressure sensitive adhesive...adjacent to the first vertically extending side edge..." (Figure 2; Column 2, lines 54 – 56).

In response to Applicant's argument that Haugwitz teaches away from "a plurality of second strips of adhesive material...adjacent to the second edge..." as required by independent claim 14 and "a plurality of vertically extending strips of pressure sensitive adhesive...adjacent



to the first vertically extending side edge...,” as required by independent claim 20, Haugwitz clearly teaches that the adhesive maybe be applied to any part of the sheet and may be presented in a variety of configurations (Column 2, lines 54 – 61). While Haugwitz does disclose a specific grasping of the sheet for removal (Column 3, lines 41 – 45), adhesive can be on both the vertical and horizontal edges of the paper, and one of ordinary skill in the art would grab the sheet on the corner opposite the adhesive corner to remove it. This action follows the specific grasp as disclosed by Haugwitz.

In response to Applicant’s argument that Vargas patent fails to teach or suggest "a plurality of first strips of adhesive material..., adjacent to the first side edge..., a plurality of second strips of adhesive material..., adjacent to the second side edge...," as required by independent claim 14, and "a plurality of horizontally extending strips of pressure sensitive adhesive..., adjacent to the first horizontally extending side edge..., a plurality of vertically extending strips of pressure sensitive adhesive..., adjacent to the first vertically extending side edge...," as required by independent claim 20, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Vargas teaches plurality of second strips of adhesive material on rear sides of the sheet adjacent to the second side edge and extending substantially from one longitudinal end of the second side edge to the other longitudinal end of the second side edge (Column 3, lines 1 – 15), a plurality of first liners respectively positioned over the plurality of first strips of adhesive material (Column 3, lines 1 – 15); and a plurality of second liners respectively positioned over

the plurality of second strips of adhesive material (Column 3, lines 1 – 15), the pluralities of first and second strips of adhesive material comprise a pressure sensitive adhesive (Column 4, lines 59 – 61). Haugwitz discloses the plurality of strips of adhesive (Column 2, lines 54 – 61).

In response to Applicant's argument that neither the Haugwitz patent, nor the Vargas patent, nor the combination of the Haugwitz patent with the Vargas patent teach or suggest at least first and second intersecting side edges..., a plurality of first strips of adhesive material... adjacent to the first side edge..., a plurality of second strips of adhesive material...adjacent to the second side edge..., a plurality of first liners respectively positioned over the plurality of first strips of adhesive material; and a plurality of second liners respectively positioned over the plurality of second strips of adhesive material," as required by independent claim 14, or "first and second horizontally extending side edges, and first and second vertically extending side edges..., a plurality of horizontally extending strips of pressure sensitive adhesive..., adjacent to the first horizontally extending side edge..., a plurality of vertically extending strips of pressure sensitive adhesive..., adjacent to the first vertically extending side edge..., a plurality of closely spaced horizontally extending release liners covering the plurality of horizontally extending strips of pressure sensitive adhesive; and a plurality of closely spaced vertically extending release liners covering the plurality of vertically extending strips of pressure sensitive adhesive," as required by independent claim 20, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Vargas teaches plurality of second strips of adhesive material on rear sides of

the sheet adjacent to the second side edge and extending substantially from one longitudinal end of the second side edge to the other longitudinal end of the second side edge (Column 3, lines 1 – 15), a plurality of first liners respectively positioned over the plurality of first strips of adhesive material (Column 3, lines 1 – 15); and a plurality of second liners respectively positioned over the plurality of second strips of adhesive material (Column 3, lines 1 – 15), the pluralities of first and second strips of adhesive material comprise a pressure sensitive adhesive (Column 4, lines 59 – 61). Haugwitz discloses the plurality of strips of adhesive (Column 2, lines 54 – 61).

#### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Fri. from 10:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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